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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,451	11/02/2001	Yoshifumi Tanimoto	81800.0170	9584
26021	7590	05/17/2005	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			BAKER, CHARLOTTE M	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/005,451	<b>Applicant(s)</b> TANIMOTO, YOSHIFUMI	
	<b>Examiner</b> Charlotte M. Baker	<b>Art Unit</b> 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/02/2001</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Detailed Action</u>                   |

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Specification*

2. The disclosure is objected to because of the following informalities: p. 2, par. 3, remove “as well as in Japan”; p. 2, par. 3, replace “))” with --)--; p. 4, par. 9, replace “TIFF is open to public” with --TIFF is open to the public--; p. 23, par. 58, replace “various function key” with --various function keys--; p. 31, par. 82, replace “dedicated line using to connect” with --dedicated line used to connect--; p. 34, par. 91, replace “various function key” with --various function keys--; p.36, par. 99, replace “forth corresponding” with --fourth corresponding--; p. 38, par. 101, replace “more modulates” with --further modulates--; p. 39, par. 105, replace “can be surely completed” with --can surely complete--; p. 39, par. 106, replace “forth – corresponding table” with --fourth corresponding table--; p. 40, par. 106, replace destination number corresponded to” with --destination number corresponding to--; p. 40, par. 106, replace “destination name corresponded to” with --destination name corresponding to--; p. 40, par. 106, replace “forth corresponding tables” with --fourth corresponding tables--; p. 40, par. 109, replace abbreviated number corresponded” with --abbreviated number corresponding--; p. 41, par. 112, replace “forth embodiments” with --fourth embodiments--; .

Appropriate correction is required.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of **50 to 150 words**. It is important that the abstract not exceed

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150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### *Claim Objections*

4. Claim 15 is objected to because of the following informalities: replace "sand" with --said--. Appropriate correction is required.
5. Claim 16 is objected to because of the following informalities: place a period at the end of the claim. Appropriate correction is required.
6. Claims 9-11 are objected to because of the following informalities: replace "further including a means for transmitting a means for transmitting an image data" with --further including a means for transmitting an image data--.

### *Claim Rejections - 35 USC § 112*

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-2, 5-6, 15-17, and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. Claim 1 recites the limitation "the corresponding network information". There is insufficient antecedent basis for this limitation in the claim.
10. Claim 2 recites the limitation "the corresponding information". There is insufficient antecedent basis for this limitation in the claim.

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11. Claim 2 recites the limitation "the discrimination information". There is insufficient antecedent basis for this limitation in the claim.
12. Claim 2 recites the limitation "the destination". There is insufficient antecedent basis for this limitation in the claim.
13. Claim 2 recites the limitation "the network information". There is insufficient antecedent basis for this limitation in the claim.
14. Claim 5 recites the limitation "the public switched telephone network". There is insufficient antecedent basis for this limitation in the claim.
15. Claim 5 recites the limitation "the computer communication network". There is insufficient antecedent basis for this limitation in the claim.
16. Claim 5 recites the limitation "the network". There is insufficient antecedent basis for this limitation in the claim.
17. Claim 5 recites the limitation "the discrimination information". There is insufficient antecedent basis for this limitation in the claim.
18. Claim 6 recites the limitation "the public switched telephone network". There is insufficient antecedent basis for this limitation in the claim.
19. Claim 6 recites the limitation "the computer communication network". There is insufficient antecedent basis for this limitation in the claim.
20. Claim 6 recites the limitation "the discrimination information". There is insufficient antecedent basis for this limitation in the claim.
21. Claim 6 recites the limitation "the destination". There is insufficient antecedent basis for this limitation in the claim.

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22. Claim 6 recites the limitation "the network information". There is insufficient antecedent basis for this limitation in the claim.

23. Claim 15 recites the limitation "the corresponding network information". There is insufficient antecedent basis for this limitation in the claim.

24. Claim 15 recites the limitation "the destination discrimination information". There is insufficient antecedent basis for this limitation in the claim.

25. Claim 15 recites the limitation "the network information". There is insufficient antecedent basis for this limitation in the claim.

26. Claim 17 recites the limitation "the public switched telephone network". There is insufficient antecedent basis for this limitation in the claim.

27. Claim 17 recites the limitation "the computer communication network". There is insufficient antecedent basis for this limitation in the claim.

28. Claim 17 recites the limitation "the network". There is insufficient antecedent basis for this limitation in the claim.

29. Claim 17 recites the limitation "the discrimination information". There is insufficient antecedent basis for this limitation in the claim.

30. Claim 17 recites the limitation "the destination". There is insufficient antecedent basis for this limitation in the claim.

31. Claim 17 recites the limitation "the network information". There is insufficient antecedent basis for this limitation in the claim.

32. Claim 19 recites the limitation "the corresponding network information". There is insufficient antecedent basis for this limitation in the claim.

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33. Claim 19 recites the limitation "the network information". There is insufficient antecedent basis for this limitation in the claim.

34. Claim 20 recites the limitation "the public switched telephone network". There is insufficient antecedent basis for this limitation in the claim.

35. Claim 20 recites the limitation "the computer communication network". There is insufficient antecedent basis for this limitation in the claim.

36. Claim 20 recites the limitation "the network". There is insufficient antecedent basis for this limitation in the claim.

37. Claim 20 recites the limitation "the discrimination information". There is insufficient antecedent basis for this limitation in the claim.

38. Claim 20 recites the limitation "the destination". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

39. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

40. Claims 1-4, 15-16, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Mehta et al. (6,819,750).

**Regarding claim 1:** Mehta et al. disclose a means for communicating (Fig. 1, sending fax 10 and receiving fax 12) via a public switched telephone network (Fig. 1, PSTN), with a

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communication device (Fig. 1, sending fax 10 and receiving fax 12) connected to said public switched telephone network (Fig. 1, PSTN), and with a gateway device (Fig. 1, sending gateway 16 and receiving gateway 18) connecting said public switched telephone network (Fig. 1, PSTN) to a computer communication network (Fig. 1, Internet 14); and, a means for transmitting an image data (facsimile or email) to said communication device (Fig. 1, sending fax 10 and receiving fax 12) **or** transmitting an image data and a discrimination information to said gateway device, based on the corresponding network information in case of inputting the destination discrimination information of image data and the network information.

**Regarding claim 2:** Mehta et al. disclose a means for communicating (Fig. 1, sending fax 10 and receiving fax 12) via a public switched telephone network (Fig. 1, PSTN), with a communication device (Fig. 1, sending fax 10 and receiving fax 12) connected to said public switched telephone network (Fig. 1, PSTN), and with a gateway device (Fig. 1, sending gateway 16 and receiving gateway 18) connecting said public switched telephone network (Fig. 1, PSTN) to a computer communication network (Fig. 1, Internet 14); and, a means for memorizing (buffer, col. 7, ln. 12-16) the corresponding information (CM message [call menu message] received in packetized form, col. 7, ln. 12-16) to the discrimination information of the destination of image data (facsimile protocol, col. 7, ln. 4-7) and the network information showing the available network (Fig. 1, Internet 14); and, a means for transmitting an image data (facsimile or email) to said communication device (Fig. 1, sending fax 10 and receiving fax 12) **or** for transmitting an image data and the discrimination information to said gateway device, based on the corresponding information.



**Regarding claim 3:** Mehta et al. satisfy all the elements of claim 1. Mehta et al. further disclose a means for judging whether the transmission of an image data (facsimile or email) using said computer network (Fig. 1, Internet 14) is completed or not (Fig. 4, process and col. 7, ln. 4-22); and, a retransmitting means for transmitting an image data (facsimile or email) to said communication device (Fig. 1, sending fax 10 and receiving fax 12) in case of judging that said transmission is not completed (Fig. 4, process and col. 7, ln. 4-22).

**Regarding claim 4:** Mehta et al. satisfy all the elements of claim 2. Mehta et al. further disclose a means for judging whether the transmission of an image data (facsimile or email) using said computer network Fig. 1, Internet 14) is completed or not (Fig. 4, process and col. 7, ln. 4-22); and, a retransmitting means for transmitting an image data (facsimile or email) to said communication device (Fig. 1, sending fax 10 and receiving fax 12) in case of judging that said transmission is not completed (Fig. 4, process and col. 7, ln. 4-22).

**Regarding claim 15:** Mehta et al. disclose a communication unit (Fig. 1, sending fax 10 and receiving fax 12) for communicating via a public switched via public switched telephone network (Fig. 1, PSTN), with a communication device (Fig. 1, sending fax 10 and receiving fax 12) connected to said public switched telephone network (Fig. 1, PSTN), and with a gateway device (Fig. 1, sending gateway 16 and receiving gateway 18) connecting said public switched telephone network (Fig. 1, PSTN) to a computer communication network (Fig. 1, Internet 14); and a transmitting unit for transmitting an image data (facsimile or email) to said communication device (Fig. 1, sending fax 10 and receiving fax 12) or transmitting an image data and a discrimination information in case of inputting the destination discrimination information of image data and the network information.

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**Regarding claim 16:** Mehta et al. satisfy all the elements of claim 15. Mehta et al. further disclose a judging unit (Fig. 1, receiving gateway 18) for judging whether the transmission of an image data (facsimile or email) using said computer network (Fig. 1, Internet 14) is completed or not (Fig. 4, process utilized by receiving gateway 18 and col. 7, ln. 4-22); and, a retransmitting unit for transmitting an image data to said communication device (Fig. 1, sending fax 10 and receiving fax 12) in case of judging that said transmission is not completed (Fig. 4, process and col. 7, ln. 4-22).

**Regarding claim 19:** The structural elements of the apparatus of claim 1 perform the steps of claim 19. Therefore, claim 19 is rejected for the same reasons discussed in the rejection of claim 1.

### ***Claim Rejections - 35 USC § 103***

41. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

42. Claims 5, 6, 12, 17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta et al. in view of Onuma (6,542,472).

**Regarding claim 5:** Mehta et al. disclose a means for connecting respectively with the public switched telephone network (Fig. 1, PSTN) and the computer communication network (Fig. 1, Internet 14); and, a means for transmitting an image data (facsimile or email) to a destination (Fig. 1, receiving fax 12) using the network shown (Fig. 1)

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Mehta et al. fail to specifically address inputting discrimination information.

Onuma discloses in a network information in case of inputting the discrimination information (col. 2, ln. 53-63) of the destination of the image data (PSTN or LAN interface), to which the network information showing which network is used is attached (col. 2, ln. 53-63).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to allow inputting of discrimination information to ensure effective use various terminals as taught by Onuma (col. 1, ln. 58-60).

**Regarding claim 6:** Mehta et al. disclose a means for connecting respectively to the public switched telephone network (Fig. 1, PSTN) and the computer communication network (Fig. 1, Internet 14).

Mehta et al. fail to specifically address discrimination information related to which network is used.

Onuma discloses a means for memorizing by making the discrimination information of the destination of an image data correspond to the network information (Fig. 1, transmission protocol determining section 104) showing which network is used whether the public switched telephone network (PSTN) or the computer communication network (Fig. 1, LAN interface 106); and, a means for transmitting an image data to said destination using the network shown in the network information corresponding to the discrimination information in case of selecting the discrimination information (col. 2, ln. 44-63).

**Regarding claim 12:** Mehta et al. in view of Onuma satisfy all the elements of claim 5. Mehta et al. further disclose further including a means for transmitting an image data to said computer communication network (Fig. 1, Internet 14) by the email method communication by SMTP

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(Simple Mail Transfer Protocol). Since there is an Internet, the Internet is capable of SMTP; therefore, this feature is implicit.

**Regarding claim 17:** Arguments analogous to those stated in the rejection of claim 5 are applicable.

**Regarding claim 20:** The structural elements of the apparatus of claim 6 perform the steps of claim 20. Therefore, claim 20 is rejected for the same reasons discussed in the rejection of claim 6.

43. Claims 7, 8, 13-14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta et al. in view of Onuma and further in view of Amit et al. (6,259,538).

**Regarding claim 7:** Mehta et al. in view of Onuma satisfy all the elements of claim 5. Mehta et al. disclose wherein a means for connecting with said public switched telephone network (Fig. 1, PSTN) is composed such as to connect with the public switched telephone network (Fig. 1, PSTN), characterized in that said network information shows which network is used among the internal network (Fig. 1), the public switched telephone network (Fig. 1, PSTN) or the computer communication network (Fig. 1, Internet 14).

Mehta et al. fail to specifically address a private branch exchange.

Amit et al. disclose via the private branch exchange (PBX, col. 6, ln. 41-46).

Incorporation of a private branch exchange disclosed by Amit et al. into the disclosure of Mehta et al. facilitates a decision making process. The PBX acts a switch between PSTN or Internet; therefore it is an implicit feature when a PBX is involved.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the PBX as taught by Amit et al. for routing facsimile messages in real-time as taught by Amit et al. (col. 1, ln. 5-7).

**Regarding claim 8:** Mehta et al. in view of Onuma satisfy all the elements of claim 6. Mehta et al. disclose wherein a means for connecting with said public switched telephone network (Fig. 1, PSTN) is composed such as to connect with the public switched telephone network (Fig. 1, PSTN) connected to the internal network (Fig. 1), characterized in that said network information shows which network is used among the internal network (Fig. 1), the public switched telephone network (PSTN) or the computer communication network (Fig. 1, Internet 14).

Mehta et al. fail to specifically address a private branch exchange.

Amit et al. disclose via the private branch exchange (PBX, col. 6, ln. 41-46).

**Regarding claim 13:** Mehta et al. in view of Onuma and further in view of Amit et al. satisfy all the elements of claim 7. Arguments analogous to those stated in the rejection of claim 12 regarding SMTP are applicable.

**Regarding claim 14:** Mehta et al. in view of Onuma and further in view of Amit et al. satisfy all the elements of claim 8. Arguments analogous to those stated in the rejection of claim 12 regarding SMTP are applicable.

**Regarding claim 18:** Arguments analogous to those stated in the rejection of claim 7 are applicable.

44. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta et al. in view of Onuma and further in view of Whitfield (6,563,599).

**Regarding claim 9:** Mehta et al. in view of Onuma satisfy all the elements of claim 5.

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Mehta et al. in view of Onuma fail to specifically address T.38 protocol.

Whitfield disclose further including a means for transmitting an image data to said computer communication network by the real-time communication by T.38 protocol (Fig. 3, T.38 encoder 35 and T.38 decoder 36).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include T.38 protocol to avoid time-out during facsimile transmissions as taught by Whitfield (col. 4, ln. 33-35).

45. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta et al. in view of Onuma and further in view of Amit et al. and further in view of Whitfield.

**Regarding claim 10:** Mehta et al. in view of Onuma and further in view of Amit et al. satisfy all the elements of claim 7.

Mehta et al. in view of Onuma fail and further in view of Amit et al. fail to specifically address T.38 protocol.

Whitfield disclose further including a means for transmitting a means for transmitting an image data to said computer communication network by the real-time communication by T.38 protocol (Fig. 3, T.38 encoder 35 and T.38 decoder 36).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to include T.38 protocol to avoid time-out during facsimile transmissions as taught by Whitfield (col. 4, ln. 33-35).

**Regarding claim 11:** Mehta et al. in view of Onuma and further in view of Amit et al. satisfy all the elements of claim 8.

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Mehta et al. in view of Onuma fail and further in view of Amit et al. fail to specifically address T.38 protocol.

Whitfield disclose further including a means for transmitting a means for transmitting an image data to said computer communication network by the real-time communication by T.38 protocol (Fig. 3, T.38 encoder 35 and T.38 decoder 36).

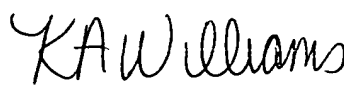
### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlotte M. Baker whose telephone number is (571)272-7459. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CMB

  
**KIMBERLY WILLIAMS**  
**SUPERVISORY PATENT EXAMINER**